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Intellectual Property Administration
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EXAMINER

KRONENTHAL, CRAIG W

ART UNIT PAPER NUMBER

2627

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,406

Applicant(s)

SIMPSON ET AL.

Examiner

Craig W. Kronenthal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,7-13,15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,14 and 17-31 is/are rejected.
- 7) ☒ Claim(s) 25-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed May 27, 2005 has been entered and made of record.
 2. The 35 U.S.C. 112 rejection to claims 5 and 6 has been withdrawn in view of the amended claims.
 3. The claim objections to claims 7 and 8 are moot since these claims were canceled.
- However, claims 25-30 still are still objected to for reasons explained below.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 17, and 25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claim 25 is objected to because of the following informalities:
 - The preamble on lines 1-2 of claim 25, should be replaced with "A computer-readable medium **storing** computer readable instructions for performing the steps of:" in accordance with 35 USC 101.

Appropriate correction is required.

6. Claims 26-30 are objected to because of the following informalities:

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- The preamble on lines 1-2 of claim 25, should be replaced with "The computer-readable medium of claim 25, further **storing** computer readable instructions for performing the steps of:" in accordance with 35 USC 101.

Appropriate correction is required.

7. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). Claim 30 depends on claim 26, but is separated by claims 27-29.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1, 2, 5, 6, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terasaki (Pub. No. US 2002/0037091 A1) in view of Wang et al. (PN 6,526,155) (hereinafter Wang).

Regarding Claim 1: Terasaki discloses a method for a user to add a watermark image to a composition, said method comprising:

- Using a network browser (Browser, Figure 1, item 32) operating on a network-connected computing device [The client (Figure 1, item 3) containing the browser (32) is connected to the network (Figure 1, item 1).] to:
- Access a watermark service (Fig. 1, 2) operating on a network server, the watermark service storing watermark images [The client (Fig. 1, 3) accesses the web server (2) (p. 2, [0027], lines 4-5). The web server (2) represents a watermark service for inserting watermark information (p. 2, [0028], line 1). The web server (2) is connected to a storage unit (Figure 1, item 23) containing watermark information (p. 2, [0028], lines 1-3).];
- Select a target composition (Fig. 1, 23a) using the watermark service, the target composition being stored on a network server such that the watermark service accesses the network server on which the target composition is stored to retrieve the target composition [The watermark insertion section (21) also selects the low resolution data (23a), which represents the target composition from the storage unit (23), which is considered a part of the entire watermark service (p. 2, [0030], lines 1-6).]; and

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- Generate a watermark composition comprising the target composition and the watermark image using the watermark service [The watermark insertion section (21) generates the watermark composition by replacing a bit plane of the low resolution data (23a) with a watermark image (p. 2, [0038], lines 9-15). Figure 2 illustrates this procedure.].

Terasaki teaches selecting a watermark image from the watermark service [The watermark insertion section (Fig. 1, 21) selects the electronic watermark from a storage unit (Fig. 1, 23), which is considered as part of the entire watermark service (p. 2, [0030], lines 1-2). The watermark itself is considered an image since it is formed into a bit plane and the bit plane is added to an image (p. 2, [0038], lines 13-15). The watermark is also shown as an image in Figure 2 as a dark parallelogram.]. Terasaki does not disclose using a network browser to select a first watermark stored by the watermark service. However, Wang teaches a user selecting a watermark from storage (Figure 2, item 240) (col. 3 lines 27-30). It would have been obvious to one of ordinary skill in the art to modify Terasaki's browser (32) to perform watermark selection as is performed by Wang's input device (Figure 2, item 310). It is obvious that if one is able to select a watermark from storage then one could select a watermark from storage on a network. Furthermore, it is obvious that a browser would be used to interface with the network in order to access the remotely stored watermark information. One would have been motivated to make this modification to give the user greater control by allowing the user's browse request to include a watermark request.

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Regarding Claim 2: Terasaki discloses the method of claim 1, wherein in accessing the watermark service, an imaging extension is used [The client (Fig. 1, 3) must make a request to the web server (Fig. 1, 2) before any information is transmitted. Therefore, it is inherent that the request be performed by a means equivalent to an imaging extension (p. 2, [0027], lines 3-5).].

Regarding Claim 5: Terasaki discloses the method of claim 1, further comprising storing the watermark composition within a composition store (Figure 1, item 34) operating on a network server [The browser (Fig. 1, 32) stores the watermark composition (23a) in a storage unit (34) (p. 3, [0044], lines 6-10). The watermark composition is the low resolution data (23a) output from the web server (2), as explained regarding claim 1.].

Regarding Claim 6: Terasaki discloses the method of claim 5, wherein storing the watermark composition comprises retaining web content such that when the web content is served to a remote service web browser, the remote service generates a hard-copy product using the watermark composition [The client (Fig. 1, 3) has a data selection driver (Fig. 1, 31), which connects the storage unit (Fig. 1, 34), storing the watermark composition (23a), to a printer (Fig. 1, 36), capable of making a hard-copy. The browser (Fig. 1, 32) represents a remote service web browser since it is separate from the web server (Fig. 1, 2). The browser (32) receives web content from the web server (2), retains the content in the storage unit (34) (p. 3, [0044], lines 6-10) for

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access by the data selection driver (31) to pass the data to a printer (36) (p. 3, [0049], lines 30-36).].

Regarding Claim 31: Wang discloses the method of claim 1, wherein the network browser is further used to display the watermark composition such that the watermark image is visible to the user (visible watermarks, Figure 1, item 110, col. 2 lines 47-53).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terasaki in view of Wang as applied to claim 1 above, and further in view of Ito et al. (Pub. No. US 2001/0013097 A1) (hereinafter Ito).

Regarding Claim 14: Terasaki as modified by Wang discloses the method of claim 1, wherein the target composition is stored, but does not disclose the storage to be associated with the user. However, Ito discloses the process of checking for authorization before allowing a user to receive the target composition (p. 2 [0034], lines 5-7). Therefore, the user is associated with the storage of the target composition. It would be obvious to one of ordinary skill in the art to modify Terasaki's low resolution data storage (23a) to require authorization with the user, as taught by Ito, thereby associating the target composition with a user. Furthermore, as suggested by Ito, one would be motivated to make this modification to prevent use of content before watermarking (p. 2, [0036], lines 1-2).

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11. Claims 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito

Regarding Claim 17: Ito discloses a system for adding a watermark to a document, comprising:

- A server including imaging-service content, the server coupled to a network, the imaging-service content comprising watermark images [The server (Fig. 1, 2) is coupled to a network (Fig. 1, 9). The server (2) contains contents (Fig. 1, not numbered), which it supplies to a client device such as a PC (Fig. 1, 4) (p. 2, [0032], lines 1-2). Furthermore, the server (2) contains a content manager (not shown), which adds the contents including an ID, representative of a watermark image, to the ID holder (Fig. 3, 16) (p. 2, [0035], lines 9-11). Also this content manager transmits content including a viewer (Fig. 3, 12), which is a means for adding at least one watermark (p. 2, [0034], lines 5-7).]; and
- A computing device coupled to the network, the computing device configured with a browser, wherein the browser is configured to receive the imaging-service content, extract data reflective of the at least one watermark image designated for integration in a product with at least one target composition stored in a data storage device communicatively coupled with the computing device, and generate a watermark composition comprising the watermark image and the target composition [The computing device is the PC (4), which is also coupled to the network (9). The PC (4) contains a viewer/browser (Fig. 3, 12), which is configured to receive and extract the content provided by the server (2) (p. 2,

[0035], lines 1-6). The browser (12) contains an ID imprinter (Fig. 3, 18), which contains a ID reader (Fig. 4, 30), which extracts an ID from the ID holder (16). The PC (4), in addition to receiving an ID from the server (2) via the network (9) and ID holder (16), receives a target composition by way of a communicatively coupled storage medium (p. 3, [0046]). The PC (4) also generates the watermark composition with its ID imprinter (18) (p. 2, [0035], lines 7-8).].

Ito does not disclose the browser enabling the user to select a watermark image contained in the imaging-service content. However, Wang teaches a user selecting a watermark from storage (Figure 2, item 240) (col. 3 lines 27-30). It would have been obvious to one of ordinary skill in the art to modify Ito's viewer/browser (12) to perform watermark selection as is performed by Wang's input device (Figure 2, item 310). It is obvious that if one is able to select a watermark from storage then one could select a watermark from storage on a network. Furthermore, it is obvious that a browser would be used to interface with the network in order to access the remotely stored watermark information. One would have been motivated to make this modification to give the user greater control by allowing the user's request to include a watermark request.

Regarding Claim 18: Ito discloses the system of claim 17, wherein the imaging-service content comprises text [The imaging-service content includes the ID unique to the user, which is added to the ID holder (Fig. 3, 16) by the content manager (p. 2, [0035], lines 9-11). This ID unique to the user is understood to be text.].

Regarding Claim 19: Ito discloses the system of claim 17, wherein the imaging-service content comprises a graphic design [Since an image decoder (Fig. 3, 14) is used to decode the imaging-service content it can be concluded that this content is an image or graphic design. Also Ito uses an image as the content in his example (p. 2, [0034], lines 2-3).].

Regarding Claim 20: Ito discloses the system of claim 17, wherein the browser comprises an imaging extension [See the analogous arguments made regarding claim 15.].

Regarding Claim 21: Ito discloses the system of claim 17, further comprising: a service server coupled to the network and a service, wherein the service server receives data from the browser [The detector (Fig. 11, 60), representing the service server, is connected to the network (Fig. 1, 9) and a display service (Fig. 11, 68) (p. 4, [0060], lines 3-7). The detector (60) reads the content after being imprinted with an ID by the browser (Fig. 3, 12) (p. 4, [0060], lines 5-6).].

Regarding Claim 22: Ito discloses the system of claim 21, wherein the data comprises resource device commands [Since the detector (Fig. 11, 60) loads the content from a storage device (Fig. 10, S10), the data sent to the communication section (Fig. 11, 62) may be a memory address for accessing the content with imprinted ID (p. 4, [0059],

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line1-4). Therefore, providing the address acts as a read command for utilizing a resource device.].

Regarding Claim 23: Ito discloses the system of claim 21, wherein the data comprises links to access the watermark composition from the data storage device [Since the detector (Fig. 11, 60) loads the content from a storage device (Fig. 10, S10), the data sent to the communication section (Fig. 11, 62) may be a memory address for accessing the content with imprinted ID (p. 4, [0059], line1-4). Therefore, the memory address acts as a link.].

Regarding Claim 24: Ito discloses the system of claim 22, wherein the resource device commands are configured to direct the creation of a hard-copy product [Although no figure portrays a box for creating a hard-copy, Ito explains that once content is imprinted copying is enabled (p. 2, [0033], lines 10-11). This copying includes both digital copying and hard-copying.].

Regarding Claim 25: Ito discloses a computer-readable medium comprising computer readable instructions for performing the steps of:

- Receiving imaging-service content comprising watermark images [The PC (4) receives the viewer (12) containing the ID holder (16), which contains watermark images (p. 2, [0035], lines 1-7).];

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- Extracting data reflective of the watermark image identified by the user [Inside the ID imprinter (18) is an ID reader (Figure 4, item 30), which selects from an ID holder (Figure 3, 16) at least one watermark image (p. 2, [0038], lines 3-5).];
- Enabling the user to identify at least one target composition designated for integration with the watermark image [The communication section (Figure 3, item 10), which acts as the identifying means and belongs to the PC (4), receives the requested target composition from a content manager via a network (Figure 1, 9).];
- Generating a watermark composition comprising the watermark image and the at least one target composition [The ID imprinter (18) acts to generate a watermark composition by combining (Figure 4, item 34) an ID, representing the watermark image, a decoded image, representing the target composition (p. 2, [0035], lines 7-8).]; and
- Storing the watermark composition [The memory (figure3, item 26) stores the imprinted image, representing the watermark composition, output from ID imprinter (18) (p. 2, [0039], lines 16-17).].

Ito discloses receiving content from a network. Ito does not disclose enabling a user to identify a watermark image. However, Wang teaches enabling a user to select a watermark from storage (Figure 2, item 240) (col. 3 lines 27-30). It would have been obvious to one of ordinary skill in the art to modify Ito's viewer/browser (12) to perform watermark selection as is performed by Wang's input device (Figure 2, item 310). It is obvious that if one is able to select a watermark from storage then one could select a

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watermark from storage on a network. Furthermore, it is obvious that a browser would be used to interface with the network in order to access the remotely stored watermark information. One would have been motivated to make this modification to give the user greater control by allowing the user's request to include a watermark request.

Regarding Claim 26: Ito discloses the computer-readable medium of claim 25, further comprising computer readable instructions for performing the step of: redirecting the watermark composition to at least one service to generate a product [Although no figure portrays a box for creating a hard-copy, Ito explains that once content is imprinted copying is enabled (p. 2, [0033], lines 10-11). This copying is synonymous with generating a product.].

Regarding Claim 27: Ito discloses the computer-readable medium of claim 25, wherein receiving comprises activity on an imaging-client device [The communication means (Fig. 3, 10) belongs to the PC (Fig. 3, 4), which is an imaging-client device (p. 2, [0031], lines 3-5).].

Regarding Claim 28: Ito discloses the computer-readable medium of claim 25, wherein extracting data is implemented with a browser [The analogous arguments of claim 11 are applicable to claim 28.].

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Regarding Claim 29: Ito discloses the computer-readable medium of claim 25, wherein identifying comprises an imaging extension operative with a browser, wherein the imaging extension communicates with a data-storage device [The analogous arguments of claim 14 are applicable to claim 29.].

Regarding Claim 30: Ito discloses the computer readable-medium of claim 26, wherein the at least one service receives the forwarded content, the forwarded content comprising a link to the watermark composition, the watermark composition residing within a personal-imaging repository [The analogous arguments of claim 23 are applicable to claim 30.].

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

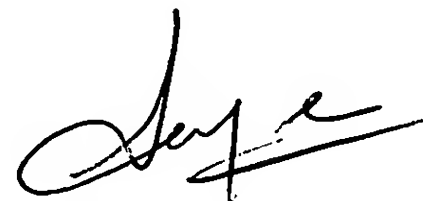
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig W. Kronenthal whose telephone number is (571) 272-7422. The examiner can normally be reached on 8:00 am - 5:00 pm / Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/12/05
CWK



SANJIV SHAH
PRIMARY EXAMINER